

REMARKS

The objection to the title has been addressed. The Specification has been checked as requested.

The rejection of Claim 6 [sic, Claim 5] under 35 USC § 112, ¶ 2 is traversed, and reconsideration is requested in light of the amendment to Claim 5. With regard to the "how" and "where" questions raised in the Office Action at page 2, attention is directed, for example, to Page 11, line 18 to Page 12, line 9 and the figures referenced therein.

The rejections of Claim 1-4 and 9-20 as being anticipated by Kurichara et al under 35 USC § 102(e) and Claims 5-8 as being unpatentable over Kurichara et al under 35 USC § 103(a) are traversed. Reconsideration of each of these rejections is respectfully requested.

First, with respect to the § 103(a) rejection, applicants must note that the Office Action does not fully adhere to what MPEP § 2113 requires and further that this section of the MPEP fails to account for an important line of decisional authority, including Atlantic Thermoplastics Co. v. Faytex Corp., 24 USPQ 2d 1138.

MPEP § 2113 requires, at the very least, that the structure implied by the process steps should be assessed when the Examiner considers the issue of patentability, especially where, as here in fact, the steps impart structural characteristics to the final product.

The Atlantic Thermoplastics case makes clear that process limitations in a product claim cannot simply be ignored. Product-by-process claims are typically based on process limitations which cannot be swept aside with a general allegation that the final product resulting therefrom would have been obvious. Just as a court must strictly adhere to everything in a product-by-process claim to determine infringement, the PTO must also adhere to everything in the claim to determine its patentability.

With regard to the Kurichara et al publication (which incidentally is assigned to the assignee of the present application), the Office Action makes no reference to where in that publication, a salient feature of the claimed invention, namely the feature found in the last paragraph of Claim 1 beginning "wherein." That is, the Office Action points to no corresponding structure in the publication because the publication does not disclose that feature. Instead, the publication shown in Figs. 27A and 27B that the substrate 5, 10 on which the elements 15, 16, 17 and 18 are mounted does not project outward laterally, i.e., in a traverse direction beyond the edges of the lead frame 2. In fact, it is just the opposite with the same issue as discussed with regard to the comparative sample shown in Figs. 20-22 of the present application.

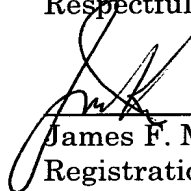
Accordingly, early and favorable consideration is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #056203.52639US).

Respectfully submitted,

April 7, 2005



James F. McKeown
Registration No. 25,406

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
JFM:crf
#365851v1